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TRADEMARK TRIAL &
APPEAL BOARD

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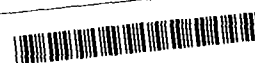
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
ON APPEAL**

Applicant	Rosch Holding S.A.
Serial No. 75/504,609	Filing Date: June 18, 1998
Trademark	ROSCH
Law Office: 116	Trademark Attorney: Andrew Benzmilller
Appeal Filed:	June 25, 2002

BOX TTAB

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513



08-28-2002

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #73

APPLICANT'S APPEAL BRIEF

Sir:

Applicant, ROSCH HOLDING S.A., has appealed the Trademark Examining Attorney's refusal to register the trademark ROSCH in respect of "toilets featuring electric fluid controls and seats sold therewith" in Class 11 on the ground that the mark is primarily merely a surname within the meaning of §2(e)(4) of the Trademark Act, 15 U.S.C. §1052(e)(4).

FACTS

Applicant's predecessor-in-interest, Rosch Technologies LLC, filed the instant application to register ROSCH on June 18, 1998 under §1(b). Applicant sought registration in respect of "toilets, electrical and fluid and controls for the toilet and seats sold as a unit." The Examining Attorney, Brian J. Pino issued an Office Action, which

was mailed on March 17, 1999 refusing registration under Trademark Act §2(e)(4), 15 U.S.C. §1052(e)(4), that the mark was primarily merely a surname.

On November 5, 2000 Rosch Technologies assigned this application to the current Applicant, Rosch Holdings S.A. In the meantime, the PTO abandoned this application for failure to respond to an outstanding Office Action.

After successfully reviving the application, Applicant mailed its response to the Office Action on January 18, 2000. Applicant argued that the mark's a combination of the name of the individual who invented the goods – ROman SCHreck. Applicant also amended the application to the Supplemental Register.

On May 18, 2000, Mr. Pino issued another Office Action maintaining the surname rejection. In addition, he refused to allow the application to be amended to the Supplemental Register until an acceptable allegation of use was filed.

On November 16, 2000, Applicant submitted its response to the outstanding Office Action. Again, Applicant argued that the mark was not primarily merely a surname. Further, Applicant explained that due to the change in ownership of the mark, acceptable use could not be demonstrated. Consequently, Applicant withdrew its amendment of the application to the Supplemental Register.

On April 18, 2001, Mr. Pino issued another Office Action, this time making the refusal to register Final. Examiner Pino offered transfer to the Supplemental Register

as an alternative. In response, Applicant submitted an Allegation to Allege use, which was accepted by the Patent and Trademark Office.

Nevertheless, on January 4, 2002, Mr. Pino issued yet another Office Action. He acknowledged that the Amendment to Allege Use was acceptable except for the fact that it referred to the Principal Register, rather than the Supplemental Register. He again invited Applicant to amend the application to the Supplemental Register, but maintained the final rejection of the application based on the surname rejection.

Since Applicant respectfully believes the Examining Attorney is incorrect, it filed its Notice of Appeal herein on June 25, 2002.

ARGUMENT

Applicant's Mark is Entitled to
Registration Since the Name "Rosch"
Is Obscure and No One Connected
With Applicant is Named "Rosch"

It is settled law that a mark is barred under Trademark Act Section 2(e)(4) only if purchasers, upon seeing the mark, will only recognize it as a surname and not as signifying some other meaning. See *Ex Parte Rivera Watch Corp.*, 106 U.S.P.Q. 145 (Comm'r Pat. & Trademarks 1955).

[I]t is the impact or impression which should be evaluated in determining whether or not the primary significance of a word when applied to a product is of surname significance. If it is, and it is only that, then it is primarily a surname (emphasis in original).

Id. At 149.

Whether a term sought to be registered is primarily merely a surname must be determined on a case-by-case basis, taking into account several factors, including (1) the rarity of the name; and (2) whether the term is in fact the name of the applicant or someone in applicant's organization. *In re Sava Research Corp.*, 32 U.S.P.Q. 2d 1380, 1380-1381 (T.T.A.B. 1994; TMEP 1211.01(a)). The burden is on the Patent and Trademark Office to prove that the term is primarily merely a surname. TMEP 1211.02(a); *In re Kahan & Weisz Jewelry Mfg. Corp.*, 508 F.2d 841, 184 U.S.P.Q. 421 (C.C.P.A. 1975); *In re Harris-Intertype Corp.*, 518 F.2d 629; 186 U.S.P.Q. 238 (C.C.P.A. 1975).

1. The Rosch Name is Obscure

In an attempt to meet his burden of showing that Applicant's mark is primarily merely a surname, TMEP 1211(02(a)), the Examining Attorney relied on 1,104 residential listings of "Rosch" from a database of about 115,000,000 names available from Phonedisc Powerfinder USA One 1998. However, as the Phonedisc printout the Examining Attorney attached to the first Office Action readily concedes "[T]he listings may contain a small number of duplicate listings for the same individuals when the individual maintained two addresses or moved." In addition, it is highly likely that some of the names include wives of men named Rosch, who only adopted their spouse's names. The list also probably contains names of children sharing an address, but with a separate telephone.

Under governing case precedent, such a meager number of Rosch as a surname as exists here, "representing about only one ten-thousandths of one percent of the surname in [the] database," demonstrates the rarity of Rosch as a surname and weighs against finding it primarily merely a surname. *In re Sava Research Corp.*, 32 U.S.P.Q. 2d at 1381 (reversing refusal to register based in part on finding that at least 100 PHONEDISC listings out of a database of 90,000,000 cited by the Examining Attorney established rarity of name and weighed in favor of finding that it would not be perceived as primarily merely a surname). *See also In re Benthin Management GmbH*, 37 U.S.P.Q. 2d 1332, 1333 (T.T.A.B. 1995)("taking into account duplicative listings, slightly more than 100 persons whose last name is Benthin", out of PHONEDISC database of more than 76,000,000 names did not establish surname significance of name.).

Applicant's own investigation, similarly, revealed a dearth of Rosch surname listings. In a Yahoo People Search of New York City, Los Angeles, Chicago and Houston, revealed only 14 distinct listings for Rosch. Such evidence strongly supports applicant's position that Rosch is not primarily merely a surname. *See In re Barcorp Industries Inc.*, 187 U.S.P.Q. 61, 62 (T.T.A.B. 1975)(fact that "Kingsland" was not listed in the Washington Metropolitan Area telephone directory supports argument that "Kingsland," while possession surname significance to some extent, would generally project other and more significant meanings and associations and, as a consequence, its primary significance to the purchasing public would not be that of a surname). *See also In re Garan Inc.*, 3 U.S.P.Q. 2d 1537, 1538 (T.T.A.B. 1987)("[s]ince the fact that

there were no 'Garan' listings in 39 phone directories favors appellant's position, we obviously cannot ignore it in determining this appeal.").

Further compelling evidence of the obscurity of the Rosch name is found in the fact that the name does not appear in a search of the website "surnamesite.com." The site proudly notes that it "built this genealogy directory of 1,000's genealogy sites that contain surnames." In short, there is strong evidence to show that "Rosch" is a rare surname in the United States.

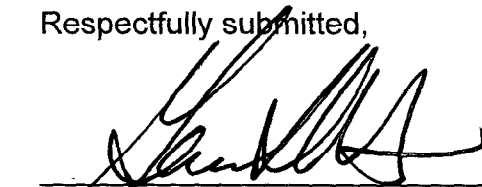
2. ROSCH is Not The Surname
Of Anyone Connected with Applicant

Rosch is not the name of anyone associated with or employed by Applicant. This fact, accordingly, also weighs in favor of registrability.. *In re Sava Research Corp.*, *supra*, 32 U.S.P.Q. 2d at 1381, *quoting In re Monotype Corp.*, 14 U.S.P.Q. 2d 1070, 1071 (T.T.A.B. 1989)("One fact that weighs in favor of finding that SAVA is not primarily merely a surname is that 'there is no evidence that [SAVA] is in fact the surname of anyone associated with applicant.'"). Rather, as Applicant explained in its first Office Action Response, it is the combination of the inventor's first and last names – ROman SCHreck. Clearly, the name ROSCH is not primarily merely a surname, and the Examining Attorney's decision should be reversed.

CONCLUSION

For the reasons stated above, applicant respectfully requests that the refusal to register the mark ROSCH be reversed and the application passed for publication at the earliest possible date.

Respectfully submitted,



Gene S. Winter, Registration No. 28,352

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Certificate of Mailing: I hereby certify that this correspondence is today being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

August 26, 2002


Barbara A. North